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NUTTER MCCLENNEN & FISH LLP SEAPORT WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604			DEAK, LESLIE R	
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MEIR ROSENBERG

Appeal 2009-011011
Application 10/656,973
Technology Center 3700

Before JENNIFER D. BAHR, STEVEN D.A. McCARTHY and
FRED A. SILVERBERG, *Administrative Patent Judges*.

McCARTHY, *Administrative Patent Judge*.

DECISION ON APPEAL

1 STATEMENT OF THE CASE

2 The Appellant appeals under 35 U.S.C. § 134 from the Examiner's
3 decision rejecting claims 1-9 and 13-27. The Examiner rejects under 35
4 U.S.C. § 103(a) claims 1-4, 6, 7, 9, 13-15 and 17-26 as being unpatentable
5 over Saul (US 2003/0032915 A1, publ. Feb. 13, 2003) and Ericson (US
6 6,533,733 B1 issued Mar. 18, 2003); and claims 5, 8, 16 and 27 as being
7 unpatentable over Saul, Ericson and Saul '495 (US 2003/0004495 A1,

1 publ. Jan. 2, 1003). We have jurisdiction under 35 U.S.C. § 6(b).

2 We AFFIRM.

3 Claim 1 is illustrative of the claims on appeal:

4 1. A method of regulating cerebrospinal
5 fluid flow in a hydrocephalus patient, comprising:

6 providing an implantable shunt system
7 having an adjustable resistance valve for regulating
8 the flow of cerebrospinal fluid into and out of a
9 ventricular cavity of the patient and including a
10 sensor element positioned in the ventricular cavity
11 for measuring a physiological characteristic of the
12 ventricular cavity, and a selectively operable
13 external system controller device for
14 communicating remotely via telemetry with the
15 implantable shunt system, the system controller
16 device being configured to effect an adjustment of
17 the resistance of the valve when the device is
18 applied to the patient;

19 manually energizing the implantable shunt
20 system with the system controller device;

21 detecting a value of the physiological
22 characteristic of the ventricular cavity measured by
23 the sensor element;

24 comparing the measured value with a
25 predetermined target value for that physiological
26 characteristic;

27 determining a desired resistance to achieve
28 the predetermined target value for that
29 physiological characteristic; and

30 adjusting a current resistance of the valve to
31 achieve the desired resistance.

ISSUES

2 Claims 1 and 17 are independent. The Appellant does not argue the
3 patentability of dependent claims 2-4, 6, 7, 9 and 13-15 separately from the
4 patentability of claim 1. Neither does the Appellant argue the patentability
5 of dependent claims 18-21 and 23-26 separately from the patentability of
6 claim 17. In fact, the Appellant does not argue the patentability of
7 independent claim 17 separately from the patentability of claim 1. (App. Br.
8 3-13; Reply Br. 2-5). The Appellant argues the patentability of claims 5, 8,
9 16 and 27 solely on the basis that Saul '495 fails to remedy deficiencies
10 which the Appellant argues exist in the combined teachings of Saul and
11 Ericson as applied to claim 1. (App. Br. 14).

12 Only issues and findings of fact contested by the Appellant have been
13 considered. See *Ex Parte Frye*, 94 USPQ2d 1072, 1075-76 (BPAI 2010).
14 The issues raised in this appeal are identified and addressed *seriatim* in the
15 “Response to Argument” section at pages 7-12 of the Answer.

FINDINGS OF FACT

18 We adopt and incorporate by reference the findings of the Examiner at
19 page 3, line 14 (starting at “In the specification and figures . . .”) through
20 page 4, line 8 (ending with “. . . control of the implant (see column 3, lines
21 5-10, 35-38, 65-67).”) of the Answer. We also adopt and incorporate by
22 reference any findings of fact which the Examiner may have made in the
23 “Response to Argument” section at pages 7-12 of the Answer.

ANALYSIS

2 The Appellant makes several arguments explaining why the Appellant
3 believes claims 1 and 22 to be patentable. The Examiner fully and
4 persuasively addresses each of these arguments in the “Response to
5 Argument” section at pages 7-12 of the Answer. We adopt the Examiner’s
6 reasoning. Based on this reasoning, we sustain the rejection of claims 1-4, 6,
7 7, 9, 13-15 and 17-26 under § 103(a) as being unpatentable over Saul and
8 Ericson. Since the Appellant argues the rejection of claims 5, 8, 16 and 27
9 solely in terms of whether the teachings of Saul ’495 would remedy the
10 alleged deficiencies in the combined teachings of Saul and Ericson as
11 applied to claim 1, we also sustain the rejection of claims 5, 8, 16 and 27
12 under § 103(a) as being unpatentable over Saul, Ericson and Saul ’495.

DECISION

15 We AFFIRM the Examiner's decision rejecting claims 1-9 and 13-27.
16 No time period for taking any subsequent action in connection with
17 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED

22 Klh